



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

1762
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JUN 19 2003
PCT 1700

In the Patent Application of

Hideo YAMANAKA et al.

Art Unit: 1762

Serial No. 09/646,680

Examiner: E. Fuller

Filed: September 20, 2000

For: FILM FORMING METHOD AND FILM FORMING APPARATUS

PETITION UNDER 37 C.F.R. §1.144

Commissioner of Patents
U.S. Patent and Trademark Office
2011 South Clark Place
Customer Window, Mail Stop PCT
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

Sir:

This is a petition under 37 C.F.R. §1.144 requesting review of a restriction requirement made by the Examiner in the Office Action mailed on December 21, 2001.

The restriction requirement of December 21, 2001 asserts an existence of the following independent and distinct inventions:

Group I, claims 1-22 drawn to a method.

Group II, claims 23-45 drawn to an apparatus.

The restriction requirement further asserts the existence of Species 1-13, having claims 1 and 23 as generic claims.

A request for reconsideration of the restriction requirement was filed on January 22, 2002 was filed within a Response Electing Invention. That Response elected with traverse the examination of the Group I claims 1-22.

In response to the request for reconsideration, the non-final Office Action mailed on March 27, 2002 maintained the restriction requirement. Also note that only claims 1, 2, 8, 9, 14, 16, 17, 20 and 21 were examined within. The remaining Group I claims 3-7, 10-13, 15, 18, 19 and 22 along with Group II claims 23-45 were restricted and withdrawn by the Examiner as non-elected inventions.

A Petition Under 37 C.F.R. §1.144 that challenged the propriety of the restriction requirement had been filed on July 29, 2002.

Note that within the Office Action of Paper No. 11, mailed on October 23, 2002, the Examiner concedes that the film forming method and apparatus share technical features with each other.

But in response to the Petition of July 29, 2002, the

Decision on Petition mailed on November 27, 2002 as Paper No. 13 denied the Petition by holding that the film forming method and apparatus (claims 1 and 23) had been shown not to make a contribution over Miyoshi and Foster, and by further holding that the Examiner's finding of lack of unity of invention was correct as a result.

An Appeal Brief was filed on March 23, 2003 to challenge the Examiner's assertion that the common technical features found within the above-identified application had been shown not to make a contribution over Miyoshi and Foster. As shown within the Appeal Brief, the film forming method and apparatus, indeed, makes a contribution over the cited prior art, especially in view of Miyoshi and Foster, thus warranting an examination of claims 3-7, 10-13, 15, 18, 19 and 22-45 previously withdrawn from consideration.

In response to the arguments made within the Appeal Brief, prosecution has been reopened upon consideration of the appeal and a new ground of rejection entered within the Office Action of June 3, 2003. In doing so, the Examiner has maintained the existence of a lack of unity of the previous Office Action, while discarding Miyoshi and Foster in favor of Desphandey et al. (U.S. Patent No. 4,961,958). Miyoshi and Foster have been discarded in favor of Desphandey despite the absence of any significant

amendment to the claims.

Accordingly, this petition pursuant to 37 C.F.R. §1.144 is proper. See 37 C.F.R. §§1.499.

For the reasons provided hereinbelow, Applicant respectfully traverses the restriction requirement made within the Office Action mailed on December 21, 2001, which has been maintained in the Office Action of June 3, 2003.

The above-identified application is an application under 35 U.S.C. §371.

M.P.E.P. §1893.03(d), provides that the principles of unity of invention are used to determine the types of claimed subject matter and the combinations of claims to different categories of invention that are permitted to be included in a single international or national stage patent application. Unity of invention, not restriction practice, is applicable in international applications and in national stage (filed under 35 U.S.C. §371) applications.

When making a lack of unity of invention requirement, the examiner must (1) list the different groups of claims and (2) explain why each group lacks unity with each other group (i.e., why there is no single general inventive concept) specifically

describing the unique special technical feature in each group.

M.P.E.P. §1893.03(d).

(1) List the different groups of claims:

The restriction requirement of December 21, 2001 lists Group I drawn to a method, having claims 1-22, while also listing Group II drawn to an apparatus, having claims 23-45.

The restriction requirement of December 21, 2001 contends that "the inventions of Groups II do not relate to a single inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding technical features for the following reasons: they correspond to various species, the technical features thereof are different." However, note that this contention of a relationship refers to only "the inventions of Groups II" (emphasis added). Thus, the restriction requirement of December 21, 2001 fails to explain why the inventions of both Group I and Group II lack unity of invention. The restriction requirement is improper on this lack of clarity alone.

(2) Explain why each group lacks unity with each other group:

M.P.E.P. §1850 describes the unity of invention before the International Searching Authority. In particular, M.P.E.P. §1850(C)(B) indicates that the method for determining unity of

invention under PCT Rule 13 shall be construed as PERMITTING an independent claim for a given process along with an independent claim for an apparatus or means specifically designed for carrying out the process *WITHIN THE SAME INTERNATIONAL APPLICATION.*

This point is reiterated within section 1893 of the M.P.E.P. regarding national stage applications filed under 35 U.S.C. §371. In particular, "an apparatus or means is specifically designed for carrying out the process when the apparatus or means is suitable for carrying out the process with the technical relationship being present between the claimed apparatus or means and the claimed process," M.P.E.P. §1893.03(d). This is further explained within Appendix AI of the M.P.E.P. as Example 2 of Annex B, PART 2.

Note that independent claim 1 is drawn to a film forming method in which a reaction gas is brought into contact with a heated catalyzer and an electric field of not higher than a glow discharge starting voltage is caused to act on the produced reactive species, thereby providing kinetic energy and carrying out vapor growth of a predetermined film on a base. Claims 2-22 are dependent upon claim 1.

Further note that independent claim 23 a film forming apparatus comprising reaction gas supply means, a catalyzer,

heating means for the catalyzer, electric field application means for applying an electric field of not higher than a glow discharge starting voltage, and a susceptor for supporting a base on which a film to be formed. Claims 24-45 are dependent upon claim 23.

Because independent claim 23 is an apparatus specifically designed for carrying out the process of independent claim 1, restriction between the Group I method and the Group II apparatus is improper. M.P.E.P. §§1850(C)(B), 1893.03(d) and Appendix AI, Annex B, PART 2, Example 2.

To explain why each group lacks unity of invention with each other group, the restriction requirement further alleges the existence of Species 1-13, and contends that these species are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In response, M.P.E.P. §1893.03(d) further explains that a group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature. The expression special technical features is defined as meaning those technical features that define the contribution which each claimed invention, considered

as a whole, makes over the prior art.

Please note that the restriction requirement of December 21, 2001 also indicates independent claims 1 and 23 as generic claims.

The existence of generic claim 1 is of itself evidence that independent claim 1 and dependent claims 2-22 contain unique special technical features therebetween. Specifically, all features present within claim 1 are also present within claims 2-22.

Additionally, the existence of generic claim 23 is of itself evidence that independent claim 23 and dependent claims 24-45 contain unique special technical features therebetween. Specifically, all features present within claim 1 are also present within claims 2-22.

The restriction requirement of December 21, 2001 contends that Species 1-13 are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1. But this linkage between the Group I invention and the Group II invention as to form a single general inventive concept under PCT Rule 13.1 is admitted within the non-final Office Action of March 27, 2002.

Specifically, the non-final Office Action of March 27, 2002 contends that Species 1 contains Group I claims 1, 2, 8, 9, 14, 16, 17, 21 and 21 along with Group II claims 24, 30, 31, 36, 38, 39, 42, 43 and 45. Thus, the non-final Office Action of March 27, 2002 admits the existence of at least one common or corresponding special technical feature between the Group I and Group II inventions, especially for the alleged Species 1.

The non-final Office Action of March 27, 2002 contends that Species 2 contains Group I claims 12 and 13 along with Group II claims 34 and 35. Thus, the non-final Office Action of March 27, 2002 admits the existence of at least one common or corresponding special technical feature between the Group I and Group II inventions, especially for the alleged Species 2.

The non-final Office Action of March 27, 2002 contends that Species 3 contains Group I claims 10 and 11 along with Group II claims 32 and 33. Thus, the non-final Office Action of March 27, 2002 admits the existence of at least one common or corresponding special technical feature between the Group I and Group II inventions, especially for the alleged Species 3.

The non-final Office Action of March 27, 2002 contends that Species 5 contains Group I claim 11 along with Group II claim 33.

Thus, the non-final Office Action of March 27, 2002 admits the existence of at least one common or corresponding special technical feature between the Group I and Group II inventions, especially for the alleged Species 5.

As further evidence of least one common or corresponding special technical feature between the Group I and Group II inventions, note that Group I claim 11 and Group II claim 33 are present in both Species 3 and Species 5. Thus, no restriction should be made between Species 3 and Species 5, at the very at least.

The non-final Office Action of March 27, 2002 contends that Species 7 contains Group I claim 15 along with Group II claim 37. Thus, the non-final Office Action of March 27, 2002 admits the existence of at least one common or corresponding special technical feature between the Group I and Group II inventions, especially for the alleged Species 7.

The non-final Office Action of March 27, 2002 contends that Species 9 contains Group I claims 3-7 along with Group II claims 25-29. Thus, the non-final Office Action of March 27, 2002 admits the existence of at least one common or corresponding special technical feature between the Group I and Group II inventions, especially for the alleged Species 9.

The non-final Office Action of March 27, 2002 contends that Species 11 contains Group I claims 3-5 along with Group II claims 25-27. Thus, the non-final Office Action of March 27, 2002 admits the existence of at least one common or corresponding special technical feature between the Group I and Group II inventions, especially for the alleged Species 11.

As additional evidence of least one common or corresponding special technical feature between the Group I and Group II inventions, note that Group I claim 3-5 and Group II claim 25-27 are present in both Species 9 and Species 11. Thus, no restriction should be made between Species 9 and Species 11, at the very at least.

The non-final Office Action of March 27, 2002 contends that Species 12 contains Group I claims 3-7 along with Group II claims 25-29. Thus, the non-final Office Action of March 27, 2002 admits the existence of at least one common or corresponding special technical feature between the Group I and Group II inventions, especially for the alleged Species 12.

As evidence of least one common or corresponding special technical feature between the Group I invention and the Group II invention, note that Group I claim 3-7 and Group II claim 25-29

are present in both Species 9 and Species 12. Thus, no restriction should be made between Species 9 and Species 12, at the very at least.

Also as evidence of least one common or corresponding special technical feature between the Group I and Group II inventions, note that Group I claims 3-5 and Group II claims 25-27 are present in both Species 11 and Species 12. Thus, no restriction should be made between Species 11 and Species 12, at the very at least.

The non-final Office Action of March 27, 2002 contends that Species 13 contains Group I claims 18, 19, and 22 along with Group II claims 40, 41 and 44. Thus, the non-final Office Action of March 27, 2002 admits the existence of at least one common or corresponding special technical feature between the Group I and Group II inventions, especially for the alleged Species 13.

As shown by the reopening of prosecution upon consideration of the arguments made within the Appeal Brief of March 23, 2003, as shown by the discarding of Miyoshi and Foster in favor of Desphandey despite the absence of any significant amendment to the claims, and as shown hereinabove regarding the admissions made by the Examiner, at least one common or corresponding special technical feature exists between the Group

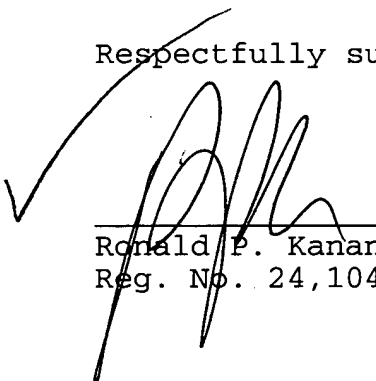
I invention and the Group II invention. A unity of invention exists and restriction is improper.

Applicant requests that the Commissioner exercise his supervisory authority under 37 C.F.R. §1.144 and withdraw this improper restriction requirement. No fee is believed to be required in connection with this petition. However, if any fee is required, authorization is given to charge Deposit Account 18-0013.

Respectfully submitted,

DATE: June 16, 2003

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